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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,190	08/09/2001	Hillel Glover	G5072.0001/P001	4263
24998	7590	03/10/2004	EXAMINER	
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP			JAGOE, DONNA A	
2101 L STREET NW			ART UNIT	
WASHINGTON, DC 20037-1526			PAPER NUMBER	

1614

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/925,190

Applicant(s)

GLOVER, HILLEL

Examiner

Donna Jagoe

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Claims 1-23 are pending in this application.

Response to Arguments

Applicant's arguments filed 4 December 2003 have been fully considered but they are not persuasive.

The rejection made in the paper mailed 27 March 2003 under 35 U.S.C. §103(a) over Dante and Carlezon and maintained in the paper mailed 17 September 2003 is hereby repeated for the reasons set forth in the previous office action and those set forth below. Applicant asserts that Dante fails to teach or suggest identifying patients with refractory depression characterized by dissociation. Applicant further asserts that the claims, as amended, recite "identifying a patient having refractory depression characterized by dissociation". Claims are not allowable that merely state a problem for solution rather than defining the method for solving the problem. *In re Hooker et al.* (CCPA, 1949 C.D. 447). Applicant included the step of identifying a subset of patients having refractory depression characterized by dissociation and has not given any method/steps for identifying said subset. Regarding applicant's allegation that the Dante reference does not teach depression characterized by dissociation, the recitation of the treatment of individuals "in need" of the treatment of a certain condition is missing. A physician will typically examine many patients with various pathologies, and only some will have a particular disease requiring a particular treatment. It has been traditional in United States practice to recite the treatment of individuals "in need" of the treatment of a certain condition so as to indicate that particular subset of patients

actually in need of intervention. Claims not specifying the subset of patients to be treated in this manner are generally viewed as being anticipated by any prior art method using a given agent since they read on administration to the general population and not a specified subset requiring treatment. Thus the claims fail to patentably distinguish over the state of the art as represented by the cited references.

Applicant has asserted that Carlezon Jr. is not prior art with respect to the instant application since the filing date of the Carlezon Jr. patent is 9 August 2001 and the instant filing date is 9 August 2001. However, the Carlezon Jr. patent claims priority to provisional application No. 60/258,029, filed 21 December 2000. The rejection of Dante and Carlezon is therefore maintained.

If a copy of a provisional application listed on the bottom portion of the accompanying Notice of References Cited (PTO-892) form is not included with this Office action and the PTO-892 has been annotated to indicate that the copy was not readily available, it is because the copy could not be readily obtained when the Office action was mailed. Should applicant desire a copy of such a provisional application, applicant should promptly request the copy from the Office of Public Records (OPR) in accordance with 37 CFR 1.14(a)(1)(iv), paying the required fee under 37 CFR 1.19(b)(1). If a copy is ordered from OPR, the shortened statutory period for reply to this Office action will not be reset under MPEP § 710.06 unless applicant can demonstrate a substantial delay by the Office in fulfilling the order for the copy of the provisional application. Where the applicant has been notified on the PTO-892 that a copy of the provisional application is not readily available, the provision of MPEP

§ 707.05(a) that a copy of the cited reference will be automatically furnished without charge does not apply.

2. The rejection made in the paper mailed 17 September 2003 under 35 U.S.C. §103(a) over Glover is maintained and hereby repeated for the reasons set forth in the previous office action and those set forth below.

Applicant asserts that Glover teaches away from the claimed invention by stating that the combination of opiate antagonist and tricyclic antidepressant would not have alleviated the patients symptoms during the numb state. However, repeating the case study in column 8, Example 2, naltrexone is used for symptoms of dissociation. When the patient became depressed, a tricyclic was added with a positive response. Thus teaching naltrexone a kappa antagonist combined with an antidepressant for depression characterized by dissociation.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

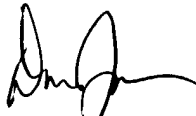
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donna Jagoe whose telephone number is (571) 272-0576. The examiner can normally be reached on Monday through Friday from 9:00 A.M. - 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on (571) 272-0584. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Donna Jagoe
Patent Examiner
Art Unit 1614



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